

**REMARKS**

Claims 1-51 are pending in this application. Claim 13 is amended. Reconsideration of the rejection in view of the amendment and the following remarks is respectfully requested.

Attached hereto is a marked-up version of the changes made to the claim by the current amendment. The attached page is captioned **“Version with Markings to Show Changes Made.”**

(1) Claims 13-18 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 is amended to change “obtainable” to “obtained” which is believed to overcome the rejection. Reconsideration and withdrawal of the rejection are respectfully requested.

(2) Claims 1-7 were under 35 U.S.C. 102(b) as being anticipated by Shaffer (U.S. 5,523,359).

Contrary to the examiner’s statement that claim 1 is anticipated by Shaffer, Shaffer fails to disclose a “living radical polymerization” as defined in claim 1. As disclosed in col. 2, lines 50-52, and col. 3, line 45 to col. 4, line 28, the invention of Shaffer relates not to a “living radical polymerization” but to a “living cation polymerization.” Therefore, the rejection is unsupported and should be withdrawn.

(3) Claims 1-4 and 8-12 were rejected under 35 U.S.C 102(a)/102(e) as being anticipated by Matyjaszewski et al. (U.S. 5,762,548).

The examiner states that in all of Examples 10-12 and 21-23 of Matyjaszewski et al., a compound having a functional group is introduced during or at the end of polymerization, thereby claim 1 is anticipated by Matyjaszewski et al. However, Matyjaszewski et al. do not disclose a compound having both a functional group and an internal alkenyl group. The compound disclosed in Examples 10-12 and 21-23 of Matyjaszewski et al. has no internal alkenyl group therein. Thus, Matyjaszewski et al. do not disclose “a compound having a functional group and an internal alkenyl group” as defined in claim 1. So, the rejection is unsupported and should be withdrawn.

(4) Claims 13-18 were rejected under 35 U.S.C. 102(a, e, b) as anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over either one of Matyjaszewski et al. or Shaffer, each one individually.

The examiner alleges that claims 13-18 are in a form of product-by-process, and because of the nature of product-by-process claims, the examiner cannot ordinarily focus on the precise difference between the claimed product and the disclosed product. However, the recitation of claim 13 is distinct from the references at least as follows:

Shaffer does not disclose "a vinyl polymer having a terminal or internal alkenyl group at a molecular terminus" as defined in claim 13. In addition, Shaffer does not disclose a living radical polymerization as described above.

In the chemical scheme in Example 23 of Matyjaszewski et al., a polymer has vinyl groups at both termini. However, from the point of one skilled in the art, the applicant concerns its non-enablement of the reference. It is considered to be difficult to obtain such a polymer having vinyl groups at both termini in accordance with the chemical scheme disclosed in col. 38, lines 55-61. Even if the claimed invention is described in a printed publication, that disclosure will not suffice as prior art if it was not enabling. The claimed invention must have been sufficiently described in the reference to have been placed in the public's possession. The disclosed chemical scheme is considered to be merely a presumption, and there is no disclosure satisfied with an enablement requirement.

(5) In view of the aforementioned amendment and accompanying remarks, claims 1-18 are in condition for allowance, which action, at an early date, is requested.


If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicants undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

U.S. Patent Application Serial No. 09/889,571

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

ARMSTRONG, WESTERMAN & HATTORI, LLP



Stephen G. Adrian

Attorney for Applicants

Reg. No. 32,878

SGA/SY/mt

Atty. Docket No. **010903**

Suite 1000

1725 K Street, N.W.

Washington, D.C. 20006

(202) 659-2930



**23850**

PATENT TRADEMARK OFFICE

Enclosures: Version with markings to show changes made

**VERSION WITH MARKINGS TO SHOW CHANGES MADE 09/889,571**

Claim 13 has been amended as follows:

13. (Twice Amended) A vinyl polymer having a [~~functional group~~] terminal or internal alkenyl group at a molecular terminus and being [~~obtainable~~] obtained by the production method according to claim1.